

REMARKS

Claim 1 has been amended to delete the limitation that the electronic sound generating member is "an electronic sound-generating member selected from the group consisting of a compact disc player, a telephone, and a radio receiver."

Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,753,870 and claim 1-7 of U.S. Patent No. 5,975,235. Applicant has submitted herewith a Terminal Disclaimer to Patent Nos. 5,975,235 and 5,975,235 to overcome the rejection.

The Examiner rejects claims 1-4 and 14-15 under 35 U.S.C. §103(a) as being unpatentable over G.W. French (U.S. Patent No. 2,573,132), in view of Antle (U.S. Patent No. 4,499,593) and also claims 5-10 and 12-13 over French '132 in view of Antle and in view of further view of Schlaegel et al. (U.S. Patent No. 5,753,870) et al. Claims 5 and 11 have been rejected under 35 U.S.C. §103(a) as unpatentable over French '132 in view of Antle and in further view of Major (U.S. Patent No. 5,488,205). Claim 16 is rejected under 35 U.S.C. §103(a) as unpatentable over French '132 in view of Antle and in further view of Kakiuchi (U.S. Patent No. 4,829,571).

French '132 discloses a hearing aid support that features light weight and small size. The device "is so constructed that the ear piece does not have to be specially designed to the user's ear" (column 1, lines 16-19). Antle discloses an audio headphone apparatus of the type that fits over the outside of the ears. Major discloses a hearing aid tubing connector for use in a hearing aid. The tubing connector features sound conduction tubing 12 that increases in diameter as it passes through the earmold for enhanced high frequency response.

1-15 Applicant respectfully traverses the cited rejections on the basis that the cited prior art does not constitute a *prima facie* case for obviousness with respect to claims 1-15 for the following reasons. First, contrary to the Examiner's statements at the bottom of page 5 of the October 23, 2002 Office Action, French does in fact exclude "any type of earmold structure." As cited previously by the Applicant, column 1, lines 16 to 23 specifically require that the earmold according to French not "be specifically designed to the user's ear." In the June 3, 2002 Final Office action in this matter, the Examiner noted that she "disagrees with applicant's

statement that French does not teach a fitted earmold" and that the present application defines the earmold as merely "able to fit within a user's ear. This statement is a mischaracterization of the specification of the present invention and of the limitation in claim 1 pertaining to the earmold being "molded to conform to and frictionally fit in a person's ear." Page 5, line 5 clearly describes "the earmold 12 which has been molded to fit the ear." "Fit the ear" and fit within a user's ear" have different meanings. As an illustration of this difference, Applicant notes that, for instance, shoes fit a person's feet, though a foot may readily fit within the shoebox in which the shoes are sold. Likewise, the ear piece of French '132 fits within the ear, but the earmold of the present invention actually fits the ear of a specific user. The Examiner has argued that the claims do not explicitly recite what portion of the ear the earmold fits to. However, applicant notes that the disclosure in French '132 of the disadvantages of an ear piece specifically tailored to an individual user's ear constitutes a clear teaching away from the limitation in pending claim 1 of an "earmold molded to conform to a person's ear." The claim limitation requires that the earmold of the present invention be tailored to a specific person's ear. Since human ears are known to vary substantially in size and shape between persons, an earmold that conforms to any part of one person's ear will most likely not conform to another person's ear.

Applicant further notes that the Examiner has misconstrued the word "molded" as recited in claim 1. It appears the Examiner considers "moldable" and "molded" and "conform" and "conformable" to be respectively equivalent terms based on the arguments presented on page 4 of the currently pending office action. In particular, the citation of silicone as being a "soft, flexible, conformable" material seems to imply that the Examiner considers the use of an adaptable material to be within the purview of claim 1. As above, Applicant suggests an analogy to illustrate the difference in these terms. Modeling clay is a "moldable" or "conformable" material in that it may deform fit the shape of a container or vessel in which it is placed and thereafter retain that shape without an elastic tendency to revert to its original shape. In contrast, pliable plastic as cited on page 3, line 8-9 is "compressible when finger and thumb pressure is applied thereto." However, once the pressure is removed, such a material rebounds to its original shape. Clay is "moldable" or "conformable" while the material recited in claim 1 is molded to a particular shape that it retains after being exposed to a pressure or deformable force.

Finally, Applicant also strongly disputes the Examiner's claim at the bottom of page 4 that it would have been obvious to one of skill in the art to use a material molded to conform to the ear for the purpose of preventing amplified sound from escaping the ear canal. The advantages of such a design are described in the specification of the present invention, but not in the cited prior art. Use of the disclosure in a application as the source of motivation to combine or modify the teachings of a prior art reference is not a proper basis for a rejection under 35 U.S.C. 103(a).

Based on the foregoing, Applicant respectfully submits that claim 1 and all of the claims dependent therefrom are in condition for allowance. Favorable consideration is therefore requested. If any issues pertaining to the above may be better resolved by phone, the Examiner is invited to call the undersigned at her convenience.

The Commissioner is hereby authorized to charge any fees associated with this communication to our Deposit Account No. 502319 (Order No. A-68724/AJT).

Respectfully submitted,



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